#9/R.T. 4/29 Elect.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Poonam BHANDARI et al.

Title: IN VIVO ASSAY SYSTEM FOR SCREENING AND VALIDATION OF DRUGS AND OTHER SUBSTANCES

Appl. No.: 09/987,482 Filing Date: 11/14/2001

Examiner: Peter Paras, Jr. Art Unit: 1632

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231
Sir:

In response to the restriction requirement set forth in the Office Action mailed March 27, 2003, Applicants hereby provisionally elect Group I, Claims 1, 4, 10, 12, and 19, for examination.

This response to restriction is made with traverse and without prejudice to applicants' right to pursue non-elected subject matter in one or more divisional applications. Applicants traverse for the following reasons, and request withdrawal of the restriction of products Groups I-III and process Groups VI-IX.

Applicants contend that the Examiner has failed to establish a *prima facie* case that the restriction is proper. As stated in MPEP § 803:

> "an application may properly be restricted to one of two or more inventions only if they are able to support separate patents and they are either independent or distinct. If the search of the entire application can be made without serious burden, the examiner **must** examine it on the merits, **even though** it includes claims to independent or distinct inventions." (MPEP § 803, emphasis added.). "There are two criteria for a proper requirement for restriction between two patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; **and** (B) There must be a serious burden on the examiner if restriction is required." (*Id.*, emphasis added, citations omitted.)

Applicants urge that the Examiner has not offered sufficient evidence to demonstrate either parts (A) or (B), that searching for the claimed compounds in the context of using them in a method for treating a protein kinase related disorder is a serious burden.

The Examiner has based the restriction requirement of Groups I-III, which respectively are related, purely on the grounds that Groups I-III are different "transgenes [of] divergent subject." Actually, the SEQ ID NOs 2 and 3 are subsets of SEQ NO 1, which is the amino acid sequence coded by the full length human APC gene. SEQ ID NO 2 is the β-catenin binding domain and SEQ ID NO 3 is the N terminal domain. Applicants contend that these sequences can be searched together without a serious burden on the Examiner. There are only three sequences to be examined, a full length sequence and two subsequences, that are included within the full length sequence. Therefore, the searching of all three of these sequences will overlap. Moreover, all of the sequences are classified in the same class and subclass, further demonstrating that the Examiner can search these sequences without an undue burden because the Examiner would only have to search one class.

Finally, the assertion that the subject matter of Groups I-III cannot be used together is erroneous. Applicants note that claims 2 and 3, which are respectively to SEQ ID NOs 2 and 3, both depend from claim 1, thereby showing that these groups are capable of use together. For the same reason, Groups IV-IX should not be restricted from Groups I-III. The claims of Groups IV-IX all recite SEQ ID NOs 1-3. The Examiner, without proffering any evidence, has merely given the personal opinion that the different transgenic *Drosophilia*, with different proteins, will work with the pending method claims. This personal opinion does not rise to the level of evidence needed for a *prima facie* case that the restriction is not proper between Groups I-III and IV-IX. Finally, applicants note that since SEQ ID NOs 1-3 are a feature of all of the method claims of Groups IV-IX, all of these groups can be examined together without a serious burden, due to overlapping subject matter and search classifications. Accordingly, examination of Groups I-IX is respectfully requested.

Should additional fees be necessary in connection with the filing of this petition, or if a petition for extension of time is required for timely acceptance of same, the

Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.

Respectfully submitted,

Date April 28, 2003

By _____

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Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.